

# Notice of Allowability

Application No.

10/727,507

Examiner

Edna Wong

Applicant(s)

MICHISHITA ET AL.

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Amendment dated January 6, 2005.

2. ☒ The allowed claim(s) is/are 11-53.

3. ☒ The drawings filed on 05 December 2003 and 13 September 2004 are accepted by the Examiner.

4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some\* c) ☐ None of the:

1. ☐ Certified copies of the priority documents have been received.

2. ☒ Certified copies of the priority documents have been received in Application No. 09/720,806.

3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.

(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached

1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.

(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☐ Notice of References Cited (PTO-892)

2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_

4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material

5. ☐ Notice of Informal Patent Application (PTO-152)

6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_

7. ☒ Examiner's Amendment/Comment

8. ☒ Examiner's Statement of Reasons for Allowance

9. ☐ Other \_\_\_\_\_

*Edna Wong*  
EDNA WONG  
PRIMARY EXAMINER

***EXAMINER'S AMENDMENT***

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

**IN THE SPECIFICATION**

page 1, line 6, under the "CROSS-REFERENCE TO RELATED APPLICATIONS" heading,

the words "The present application claims priority to Japanese Application No. 10-188879, filed July 3, 1998, and WIPO Application No. PCT/99/03489, filed June 29, 1999. The present application also claims priority to the U.S. Application Serial No. 09/720,806, filed January 3, 2001, now abandoned." have been deleted;

and replaced with the words -- The present application is a division of US Application Serial No. 09/720,806, filed January 3, 2001, now abandoned, and a National Stage Application of PCT/JP99/03489, filed June 29, 1999, which claims priority to Japanese Application Serial No. 10-188879, filed July 3, 1998, and Japanese Application Serial No. 10-188880, filed July 3, 1998. --.

**IN THE CLAIMS**

Claim 12, line 1, the word -- preparation -- has been inserted after the word "The"

(first occurrence).

Claim 13, line 1, the word -- preparation -- has been inserted after the word "The"  
(first occurrence).

### ***REASONS FOR ALLOWANCE***

The following is an examiner's statement of reasons for allowance:

Claims **11-51** are allowable over the prior art of record because the prior art does not teach or suggest a process for preparing a vitamin D derivative, comprising the steps of (a) providing, (b) irradiating and (c) subjecting as presently claimed, esp., wherein the ultraviolet irradiation apparatus comprises a projection lens positioned to be struck by and to irradiate the solution of the provitamin D derivative in the reaction container with the ultraviolet rays through the quartz rod, the projection lens being configured to control a spot size of the ultraviolet rays having the specific wavelength.

The prior art does not contain any language that teaches or suggests the above. *Sato et al.* do not teach an ultraviolet irradiation apparatus comprising a projection lens positioned to be struck by and to irradiate the solution of the provitamin D derivative in the reaction container with the ultraviolet rays through the quartz rod, the projection lens being configured to control a spot size of the ultraviolet rays having the specific wavelength. Therefore, a person skilled in the art would not have been motivated to adopt the above conditions, and a prima facie case of obviousness cannot be

established.

Claims **52 and 53** are allowable over the prior art of record because the prior art does not teach or suggest a process for preparing a vitamin D derivative, comprising the steps of (a) providing, (b) irradiating and (c) subjecting as presently claimed, esp., wherein the ultraviolet irradiation apparatus comprises a quartz rod positioned to be struck by the ultraviolet rays from the optical system and configured to directly irradiate the solution of the provitamin D derivative in the reaction container with the ultraviolet rays.

The prior art does not contain any language that teaches or suggests the above. *Sato et al.* simply teaches setting wavelength and an integrator to obtain the desired monochromatic UV ray and quantum of energy. Therefore, a person skilled in the art would not have been motivated to adopt the above conditions, and a prima facie case of obviousness cannot be established.

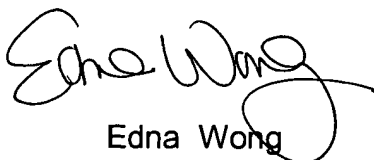
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 3:30 pm, Flex

Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Edna Wong  
Primary Examiner  
Art Unit 1753

EW  
January 27, 2005